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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,408	11/19/2003	Mark Meister	3222.1320001	5313
26111 7590 02/05/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
LIM, KRISNA				
ART UNIT		PAPER NUMBER		
2453				
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02/05/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/715,408

Applicant(s)

MEISTER ET AL.

Examiner

Krisna Lim

Art Unit

2453

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. Claims 1-22 are still pending for examination, and claims 23-29 are newly added for examination. Claims 14-22 were withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/22/08.

2. Applicant's election with traverse of Group I, claims 1-13 (including newly added claims 23-29) in the reply filed on 10/22/08 is acknowledged. The traversal is on the ground(s) that the claims are not distinct because they do not overlap in scope (see the applicant's remark on pages 12-13). This is not found persuasive because the combination does not require the particulars of the subcombination as claimed for patentability (see examiner's restriction requirement in the previous office action) and the subcombination has utility by itself. For example, the specific characteristics set forth in the subcombination claims are not set forth in the combination claims and the patentability of the combination does not rely on the detail of the specific subcombination (see the examiner's restriction requirement in the previous office action).

The requirement is still deemed proper and is therefore made FINAL

3. Claims 12, 13 and 28-29 recites the limitation "computer readable storage medium", "computer-readable medium", "first module", "second module", "third module" and "means for recognizing ...", "means for alerting ...", and "means for allowing ...". Such proclaimed in the claimed language is not mentioned at all in

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the specification. Thus, there is insufficient antecedent basis for this limitation in the claim.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 and 23-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation to the claims does not even mention or support in the original specification including the material from the parent application 09/337,035. The following limitations does not fully described in the original specification:

a) recognizing whether a complete electronic mail message composed by a virus. The applicant is reminded that the term virus is only mention once in the prior art section in paragraph 12 which states that "today computer viruses can compose and send e-mail without user being aware of the transmission of such unauthorized e-mail". In paragraph 11, the specification mentions only that a system will recognize or detect and alert the user to incomplete or improper addresses before a message is sent and allow the user to correct the addresses. On the contrary, in paragraph 32, the specification disclosed that the user was the one who created the message, not the virus as claimed. Thus, the original specification does not clearly disclose the claimed feature of recognizing whether a complete electronic mail message composed by a virus.

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- b) alerting a system user on the sending side as to **the complete** electronic mail message being sent; and allowing a user to authorize sending **the complete** electronic mail message. Yes, the specification does teach the feature of alerting the system user and allowing the user to authorize sending the message, but not a complete electronic mail message as claimed.
 - c) The send function is initiated by an unauthorized agent is not even mention in the original specification.
 - d) The unauthorized agent is the virus is not even mention in the original specification.
 - e) recognizing whether a complete electronic mail message composed by a process. The applicant is reminded that the term process is only mention in a brief description of the drawings which says nothing that this complete electronic mail message is composed by a process. On the contrary, in paragraph 32, the specification disclosed that the user was the one who created the message, not the process as claimed. Thus, the original specification does not clearly disclose the claimed feature of recognizing whether a complete electronic mail message composed by a process.
 - f) The process is a virus is not even mention in the original specification.
 - g) The process is an unauthorized agent is not even mention in the original specification.
 - d) The unauthorized agent is the virus is not even mention in the original specification.
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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January 08, 2009

/Krisna Lim/

Primary Examiner, Art Unit 2453